

REMARKS/ARGUMENTS

Claims 1, 45 remain unchanged.

The Examiner rejected independent claim 1 under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774).

The Examiner argued that Young et al disclose the limitations of the “merchant server”, “payment server”, “authentication server”, “communication device” and “fulfillment server” as claimed in claim 1 of the present application and that Gobburu et al disclose the limitation of the “routing the authorization and payment card” as in claim 1. It was then argued that it would have been obvious to combine the two cited documents to arrive to the present invention. Applicant strongly disagrees with the Examiner’s assessment and traverses the obviousness rejection because of the following differences between Young et al and/or Gobburu et al and the invention of claim 1:

A. The Young et al patent does not teach a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card identification information stored in said payment card .

Actually, Young et al teach away from such a solution by saying that “ The electronic wallet 17 comprises payment data related to the user 5 previously entered by the user. For example, the wallet contains a preferred method of payment comprising a credit card type, number, and expiration date” (0057).

B. The Young et al patent does not refer to purchasing digital goods, such as electronic cash, electronic tickets, electronic coupons, loyalty points, credits for pre-paid mobile airtime, etc. On the contrary, Young et al teach buying physical goods online such as a coat viewed in a retail store (0048).

C. Furthermore, Young et al do not teach that “ the fulfillment server transmits the digital good via the authentication server to the communication device”. A physical good, such as a coat cannot be transmitted via the authentication server to the communication device.

Contrary to that in the present invention “the fulfillment server is adapted to receive payment confirmation from the payment server and transmit the digital good via the authentication server to the communication device, wherein the communication device stores the digital good onto the payment card”

D. Furthermore, Young et al do not teach storing the digital good onto the payment card , whereas claim 1 of the present invention does; see claim 1 “wherein the communication device stores the digital good onto the payment card”.

E. The Examiner admitted that Gobburu et al do not disclose the limitations of the “merchant server”, “payment server”, “authentication server” “communication device” and “fulfillment server”. Indeed Gobburu et al, lack the above mentioned elements. Gobburu et al, teach a mobile communications device (phone) that communicates with light in bar code form with a system that uses a bar code scanner for reading information communicated via the phone (column 7, lines 43-47). This has nothing to do with the present invention. Furthermore, this is so far removed from the Young et al patent, that there is no reason or motivation to combine it with the Young et al patent, as the Examiner argued.

Based on the above mentioned differences A-E the present invention of claim 1 is patentably distinguishable from Young et al alone or Gobburu et al alone or their combination.

Claims 2-22 depend upon claim 1 and since claim 1 is patentably different from Young et al and/or Gobburu et al they are also patentably different from Young et al and/or Gobburu et al.

The same differences A-E are valid for method claim 23 and for claims 24-45 that depend upon it. Therefore they are also patentably different from Young et al and/or Gobburu et al.

The Examiner further rejected dependent claims 12, 14, 20, 35, 37 and 43 under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and in further view of Jacobson (Us Publication No: 2003/0004876).

In addition to the above mentioned differences we need to mention that the Jacobson reference is not an appropriate reference for the suggested combination because it was first published on January 2, 2003 and the present invention has a priority date of December 2, 2002. Accordingly, the inventors arrived to the present invention prior to and without having knowledge of the Jacobson published application.

Furthermore, with all due respect, Jacobson paragraph (0015) does not say that the “wireless communication device comprises a subscriber identification module (SIM) card slot and said payment card module is electrically connected to said SIM card slot.”, as claimed in claims 14 and 37 of the present invention. Jacobson describes a prior art electronic device capable of accommodating a multimedia card (MMC) and a SIM card. The rear housing portion includes a dual card reader and a recess for accommodating a battery pack. The dual card reader includes a reader housing and a drawer. For electrically connecting the MMC and the SIM with the electronic device the user places the MMC and the SIM in the drawer, inserts the drawer in the recess and slides the drawer in the reader housing. Since the recess is a battery pack recess and not a SIM card slot the cited prior art reference does not read on claims 14 and 37.

It is believed that all of the pending claims have been addressed in this paper. Failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the above, it is submitted that all rejections of claims 1-45 are overcome and all claims 1-45 are in condition for allowance. Reconsideration of the claims rejection is requested and allowance of all claims at an early date is solicited.

If this response is found to be incomplete, or if a telephone conference would otherwise be helpful, please call the undersigned at 617-558-5389.

Respectfully submitted,

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I hereby certify under 37 CFR 1.10 that this correspondence is being electronically submitted on the date indicated above and is addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450